

REMARKS

I. Claim amendments

Claims 1, 18, 27, and 28 have been amended to more clearly define the claimed invention. Claims 1 and 27 have also been amended to recite that the first and second holding parts open at the analyzing position to receive a sample from the feeding means, and close at the analyzing position for analysis of the sample. Support for this amendment is provided by the specification at page 3, lines 19-27.

Claims 1, 18, 27, and 28 have been amended to delete the term "solid" as Applicants believe this term is not necessary to distinguish the claimed invention over any cited prior art.

Upon entry of this Amendment, claims 1-3, 6-23, and 25-28 are pending. No new matter has been added by any amendment herein.

II. Claim rejections – 35 U.S.C. §103

A. Hammond, Trygstad, Wong, and Schilling

Claims 1-3, 6-11, 17, and 26 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over EP 896,215 to Hammond et al. ("Hammond") in view of EP 767,369 to Trygstad ("Trygstad"), US 5,463,223 to Wong et al. ("Wong"), and DE 4441686 to Schilling ("Schilling"). The Examiner alleges that it would have been obvious to combine Hammond, Trygstad, Wong, and Schilling to arrive at the claimed invention.

Applicants reply that the cited combination of references does not disclose or suggest the claimed invention.

The invention of amended claim 1 defines an apparatus for analyzing pharmaceutical samples. The apparatus comprises means for feeding a sample through an analyzing position and means for temporarily fixing the sample at an analyzing position. The fixing means comprise first and second holding parts which open at the analyzing position to receive the sample from a feeding means, and which close around the received sample at the analyzing position for analysis. The first and second holding parts are integral components of the apparatus, and are continuously located at the analyzing position to open and close for sample analysis.

Advantageously, the present invention obviates the requirement of prior art apparatuses that a sample be fixed in a sample holder located remotely from the analyzing position, and manually inserted into the apparatus at the analyzing position for analysis. The present invention improves the reproducibility of the data obtained.

Applicants refer to their remarks of record in the Amendment filed March 31, 2005 of record distinguishing the claimed invention over Hammond, Trygstad, and Schilling. In brief, Hammond, Trygstad, and Schilling do not disclose or suggest a sample presentation apparatus having first and second holding parts which open at the analyzing position to receive a sample and which close about the sample at the analyzing position for analysis. Applicants submit that Wong does not overcome the deficiencies of Hammond, Trygstad, and Schilling to suggest the claimed invention.

Wong

The Examiner alleges that Wong in Fig. 7 discloses a sample holder "where at the analyzing position, the holding parts are adapted to move between an open position where the sample is provided for analysis and a closed position where the sample is analyzed" (Office Action, page 3).

Wong discloses a disposable micro sample holder for analyzing samples (Abstract). A sample is placed in the sample holder, which is then placed in a spectrometer, i.e. a Nicolet Magna 550 instrument (col. 10, lines 6-8) for analysis.

In Figure 7, Wong discloses a sample holder having screws for releasably clamping the two sections of the sample holder (col. 9, lines 9-14). The screws can be manipulated to adjust the pressure imparted by the optical windows on the sample.

In contrast to the claimed invention as defined by the amended claims, Wong does *not* suggest that the sample holding parts are open at the analyzing position to receive a sample from a feeding means and that the sample holding parts close at the analyzing position for analysis. Wong also does not suggest that the sample holding parts are adjusted while the sample holder is mounted in the spectrometer or, for that matter, that the holding parts are continuously located at the analyzing position to open and close for sample analysis. Applicants submit that the only fair reading of Wong is that a sample is clamped in the sample holder at a site remote from the

Serial No. 09/806,801, filed April 4, 2001

Docket No. 1103326-0659

Page 9 of 10

analyzing position, and that the sample holder is then manually inserted into a spectrometer for analysis. There is no disclosure by Wong to support a contrary position.

As such, Wong does not remedy the deficiencies of Hammond, Trygstad, and Schilling to suggest the claimed invention, and Applicants submit that Wong is cumulative to Hammond and Trygstad. Accordingly, none of the cited references, whether taken alone or in combination, suggest the claimed invention.

Furthermore, the Examiner's need to rely upon four separate references to allegedly arrive at the claimed invention further demonstrates the non-obviousness of the invention. The Examiner's selection of particular features from such a large number of references to allegedly reconstruct the invention would not have been possible without the benefit of Applicants' disclosure. Applicants therefore submit that the Examiner is engaging in impermissible hindsight in rejecting the pending claims.

Accordingly, the rejection of claims 1-3, 6-11, 17, and 26 under 35 U.S.C. §103(a) is improper and should be withdrawn.

B. Hammond, Trygstad, and Schilling

Claims 12, 14-16, 18-23, and 25 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Hammond in view of Trygstad and Schilling.

Each of claims 12, 14-16, 18-23, and 25 is directly or indirectly dependent upon claim 1. However, the Examiner has not cited Wong in combination with Hammond, Trygstad, or Schilling. Accordingly, Applicants rely on their preceding comments in Section II(A), above, and submit that the Examiner has not established a *prima facie* case of obviousness. The rejections of claims 12, 14-16, 18-23, and 25 under 35 U.S.C. §103(a) is improper and should be withdrawn.

C. Hammond and Wong

Claims 27 and 28 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Hammond in view of Wong.

Applicants rely on their remarks of record regarding Hammond, and on their discussion of Wong in Section II(A), above, in distinguishing the invention of claims 27 and 28 over the

Serial No. 09/806,801, filed April 4, 2001

Docket No. 1103326-0659

Page 10 of 10

cited prior art. In brief, neither Hammond nor Wong suggest an apparatus or method for analyzing pharmaceutical samples which comprises two sample holding parts which open at the analyzing position to receive the sample from a feeding means, and which close about the sample at the analyzing position for analysis. Advantageously, the claimed apparatus and method permit rapid sample analysis and eliminate manual handling of samples, thereby improving consistency and reproducibility of test data.

Withdrawal of the rejection of claims 27 and 28 under 35 U.S.C. §103(a) is respectfully requested.

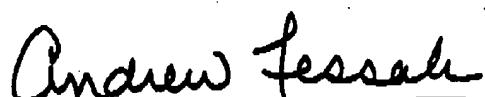
III. Conclusion

Upon entry of this Amendment, claims 1-3, 6-23, and 25-28 remain pending. Applicants respectfully submit that claims 1-3, 6-23, and 25-28 are distinguishable over the cited prior art, and are directed to patentable subject matter. Accordingly, Applicants request allowance of the claims.

Authorization is hereby given to charge any fee due in connection with this communication to Deposit Account No. 23-1703.

Dated: Aug. 26, 2005

Respectfully submitted,



Andrew Fessak
Reg. No. 48,528
Customer No. 07470
White & Case LLP
Direct Line: (212) 819-8437